REMARKS

Formal Matters

Claim 8 has been cancelled without prejudice. Claim 1 has been amended to include the limitations presented in original Claim 8. No new matter has been presented in amended Claim 1. Claims 1-7 remain in the instant Application and are presented for the Examiner's reconsideration in light of the above Amendments and the following comments.

Rejection Under 35 U.S.C. §103

Claims 1-8 have been rejected under 35 U.S.C. §103(a) over Chen, et al., U.S. Patent No. 5,990,377 in view of Applicants' admission further evidenced by Müller, GB Patent No. 2,376,436 A; Roussel, et al., International Publication No. WO 99/45205; Hein, et al., U.S. Patent No. 5,863,107 B2; or Kamps, et al., U.S. Patent No. 5,702,571. Claims 1-8 have been rejected under 35 U.S.C. §103(a) over Luu, et al., U.S. Patent No. 6,352,700 in view of *Kamps*. Applicants respectfully traverse these rejections for the following reasons:

1. Applicants' Claim 1, as amended, now claims a method for making a tissue paper product comprising the steps of, *inter alia,* passing the tissue paper web through an embossing nip and applying a transferable lotion to at least portions of the tissue paper web such that the tissue paper product is adapted to transfer a first quantity of lotion upon stationary contact with a glass surface and a second quantity of lotion upon dynamic contact with a glass surface. The ratio of the second quantity to the first quantity is at least 2:1.

2. Contrary to Applicants' claimed invention, neither the *Chen* reference and the secondary references associated thereto, nor the *Luu* reference and the secondary references associated thereto, provide for a method for making a tissue paper such that the tissue paper product transfers a first quantity of lotion upon stationary contact with a glass surface and a second quantity of lotion upon dynamic contact with a glass surface.

"Even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention." *See National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 69 U.S.P.Q. 2d 1614 (Fed. Cir. 2004) (citing *Ecolochem, Inc. v. S. Cal. Edison Co.,*

220 F.3d 1361, 1371 (Fed. Cir. 2000)). Further, even if the Examiner were able to find all the elements of Applicants' claimed invention in a combination of prior art references, "a proper analysis under Section 103 requires, *inter alia,* consideration of two factors: 1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and 2) whether the prior art would have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *See Velander v. Garner,* 348 F.3d 1359, 68 U.S.P.Q. 2d 1769 (Fed. Cir. 2003) (citing *In re Vaeck,* 947 F. 2d 488, 493 (Fed. Cir. 1991) (citing *In re Dow Chemical Co.,* 837 F.2d 469, 473 (Fed. Cir. 1988)). Further, "both the suggestion and the reasonable expectation of success 'must be founded in the prior art, not in the applicant's disclosure.'" *Id.*

Because of these considerations, it is difficult for Applicants to understand how the *Chen* reference and the associated secondary references, as well as the *Luu* reference and the associated secondary references cited by the Examiner can suggest Applicants' claimed invention. In short, the *Chen, Luu,* and secondary references, alone or in combination, fail to disclose, teach, suggest, or render obvious each and every recited feature of Applicants' Claim 1. Additionally, because dependent Claims 2-7 all depend directly from Applicants' independent Claim 1, they each contain all of its limitations. For this reason, Applicants submit that the arguments made above concerning the allowability of Claim 1 are equally applicable to the rejection of Claims 2-7 under 35 U.S.C. §103(a). Applicants therefore request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejections forthwith.

Conclusion

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims is respectfully requested.

If any additional charges are due, the Examiner is authorized to deduct such charge from our Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By _____

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